

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

Rare Names, Inc., d/b/a BuyDomains.com,
Inventory Management

Plaintiff,

v.

Foster, Andrew & Co., Inc. and
FACI Industries Corporation

Defendants.

Civil Action No.

Jury Trial Demanded

COMPLAINT

This is an action for declaratory and injunctive relief to establish that Plaintiff's registration and use of the domain name <faci.com> is not unlawful and does not violate any valid and enforceable rights of Defendants.

NATURE OF THE ACTION

1. This action is brought under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202.
2. Plaintiff seeks a declaration, pursuant to the Lanham Act, 15 U.S.C. § 1114(2)(D)(v) and 15 U.S.C. § 1125(d), that its registration and use of the Domain Name <faci.com> is not unlawful under the Anticybersquatting Consumer Protection Act.

PARTIES

3. Rare Names, Inc., d/b/a BuyDomains.com, Inventory Management (hereinafter "BuyDomains.com") is a corporation organized and existing under the laws of the State of Delaware having a principal place of business at 225 Wyman Street, Waltham, Massachusetts 02451.

4. BuyDomains.com is a wholly owned subsidiary of NameMedia, Inc. (hereinafter “NameMedia”), a Delaware corporation have a principal place of business at 225 Wyman Street, Waltham, Massachusetts 02451.
5. Upon information and belief, Defendant Foster, Andrew & Co., Inc. (hereinafter, “Foster Andrew”) is a corporation organized and existing under the laws of the State of Illinois, having a principal place of business at 480 Woodcreek Drive, Bolingbrook, Illinois 60440.
6. Upon information and belief, Defendant FACI Industries Corporation (hereinafter, “FACI Industries”) is a corporation organized and existing under the laws of the State of Illinois, having a principal place of business at 480 Woodcreek Drive, Bolingbrook, Illinois 60440.

JURISDICTION AND VENUE

7. Subject matter jurisdiction is proper under 28 U.S.C. § 1331, § 1338 and § 2201 and 15 U.S.C. § 1121 because this action involves a federal question arising under 15 U.S.C. § 1114(2)(D)(v) and 15 U.S.C. § 1125(d).
8. On information and belief, Defendants regularly engage in interstate commerce with businesses and individuals located in the Commonwealth of Massachusetts, and are doing business within this judicial district.
9. This Court has general and specific personal jurisdiction over Defendants, including via the Massachusetts Long Arm Statute, M.G.L.A. chapter 223A, § 3.
10. Venue is proper under 28 U.S.C. § 1391(b) and § 1391(c)(2).

BACKGROUND

11. BuyDomains.com registered the Domain Name <faci.com> on May 27, 2003. Currently, the Domain Name is registered with TUCOWS, INC (hereinafter, “the Registrar”), which, upon information and belief, has a principal place of business in Toronto, Ontario, Canada.
12. Since 1999, NameMedia has developed a large portfolio of domain names incorporating common words, acronyms, generic dictionary words and phrases, and surnames, some of which are offered for sale to the general public through BuyDomains.com.
13. BuyDomains.com registered and has used the Domain Name <faci.com> in good faith since May 27, 2003 for the purpose of providing visitors to the site the opportunity to follow links relevant to the non-trademark significance of the term, such as surnames and acronyms.
14. Upon information and belief, Defendants claim trademark rights in the acronym FACI for metal castings, and “Foster Andrew & Co Inc. AKA FACI Industries Corporation” holds a federal trademark registration for the mark FACI (and Design), U.S. Registration No. 4,008,715, registered on August 9, 2011.
15. On November 22, 2011, Jason Hu of Foster Andrew contacted BuyDomains.com in Massachusetts to demand that it relinquish the Domain Name <faci.com>.
16. On December 12, 2011, NameMedia responded in writing to Foster Andrew’s request, asserting that Domain Name had been registered and was being used in good faith and that no likelihood of confusion resulted from this *bona fide* use.

17. Thereafter, on January 26, 2012, FACI Industries filed Case No. D2012-0146 with the World Intellectual Property Organization Arbitration and Mediation Center (WIPO) in accordance with the Uniform Domain Name Dispute Resolution Policy (the UDRP) to force NameMedia to transfer ownership of the Domain Name <faci.com> to FACI Industries.
18. On or about April 13, 2012, the arbitration Panel in the UDRP proceeding issued its ruling in favor of FACI Industries.
19. On April 25, 2012, in accordance with the UDRP policy and rules, the Registrar notified the parties that the Panel's decision would be implemented at the close of business on May 9, 2012 unless Respondent provided evidence that it had initiated a Federal Action in order to prevent the transfer of the <faci.com> Domain Name.

COUNT I

Declaration under the Anticybersquatting Consumer Protection Act

20. Plaintiff hereby incorporates the allegations of paragraphs 1 through 19 as if set forth here in full.
21. BuyDomains.com's registration and use of the <faci.com> Domain Name does not violate federal trademark law and is wholly permissible under both federal and state trademark laws.
22. In registering the Domain Name <faci.com> BuyDomains.com did not have a bad faith intent to profit from Defendants' trademark rights in FACI (and Design) for any product of Defendants, as contemplated by 15 U.S.C. § 1125(d)(1)(A)(i).
23. The Domain Name <faci.com> is not identical, confusingly similar to, or dilutive of Defendants' FACI (and Design) trademark for any product of Defendants, as contemplated by 15 U.S.C. § 1125(d)(1)(A)(ii).

24. BuyDomains.com believed and had reasonable grounds to believe that its registration and use of the Domain Name <faci.com> was in connection with a *bona fide* offering of goods and services and was lawful, as provided in 15 U.S.C. § 1125(d)(1)(B)(ii).
25. As required by 15 U.S.C. § 1114(2)(D)(v), Plaintiff has given notice to Defendants of Plaintiff's intent to file an action to establish that Plaintiff's registration and use of the Domain Name <faci.com> is not unlawful under the Anticybersquatting Consumer Protection Act.
26. A dispute exists between Plaintiff and Defendants concerning Plaintiff's right to register and use the Domain Name <faci.com>. As a consequence thereof, an actual and justiciable controversy exists between Plaintiff and Defendants.
27. Plaintiff seeks a declaration that its registration and use of the <faci.com> domain is lawful and the UDRP Panel's decision is incorrect and contrary to law.
28. Plaintiff is and will be irreparably harmed if the <faci.com> domain is transferred to either Defendant.

RELIEF REQUESTED

Wherefore, Plaintiff requests that this Court enter judgment:

- A. declaring that Plaintiff's registration and use of the Domain Name <faci.com> is not unlawful under the Anticybersquatting Consumer Protection Act;
- B. declaring that Plaintiff's registration and use of the Domain Name <faci.com> is lawful;
- C. declaring that Plaintiff is not required to transfer the Registration for the Domain Name <faci.com> to either Defendant;
- D. entering a permanent injunction enjoining the Registrar from transferring the <faci.com> Domain Name to either Defendant;

- E. entering a permanent injunction enjoining Defendants not to accept a transfer of the Domain Name <faci.com> or claiming ownership thereof;
- F. awarding Plaintiff its reasonable costs and attorneys' fees; and
- G. awarding Plaintiff such other relief as the Court deems just and proper.

Request for Jury Trial

Plaintiff requests a trial by jury on all issues so triable.

Respectfully submitted,

RARE NAMES, INC.,
d/b/a BUYDOMAINS.COM, INVENTORY
MANAGEMENT,

By: /s/ Ann Lamport Hammitte
Ann Lamport Hammitte (BBO #553,263)
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Dated: May 3, 2012

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